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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,820	08/21/2003	Jou-Chen Chieng	MR2723-302	6179

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EXAMINER

BLAKE, CAROLYN T

ART UNIT PAPER NUMBER

3724

DATE MAILED: 11/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/644,820	Applicant(s) CHIENG, JOU-CHEN	
	Examiner Carolyn T Blake	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the safety rim protruding from the worktable board and the safety rim as a spring must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 3.
3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The specification is objected to under 37 CFR 1.71. The disclosure is insufficient as to what is intended by a rim that is a spring. It is unclear why a spring rim would be advantageous and how the spring would attach to the paper holder.

Claim Objections

4. Claim 1 is objected to because line 25 (page 7) and lines 1-2 (page 8) state, "both sides of said paper holder is coupled," while it should likely read - both sides of said paper holder are coupled- -. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contain(s) subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not clear as to what is intended by a rim that is a spring. It is unclear why a spring rim would be advantageous and how the spring would attach to the paper holder.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the top edge" in line 3. There is insufficient antecedent basis for this limitation in the claim. Furthermore, it is not understood where

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the top edge of the worktable board is located and which side the top edge extends from.

Claim 1 refers to a depth guide in line 7. However, it is not clear from the drawings or the specification how the depth guide acts to direct the depth. It appears that the depth guide is merely a clip.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "rubble element" in claim 1 is not a common term in the paper cutting art and is used by the claim to mean "a disc", while the accepted meanings are "broken fragments" or "rough stone." The term is indefinite because the specification does not clearly redefine the term.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shapiro et al (3,463,041) in view of Kozyrski (5,845,554), Jones, III et al (4,738,177), and Johnson (3,385,149).

Regarding claim 1, Shapiro et al disclose a two-shaft safety cutter (FIGS 1-3), comprising essentially of a worktable board set with a worktable board (17) for placing a paper to be cut (FIG 1). Shapiro et al further disclose a side guide set, comprising a side guide (13) fixed to one side of said worktable board (17). To the degree the term "depth guide" is understood (see 35 USC § 112 rejection above), a depth guide (14) is disclosed having thereon a bolt hole (FIG 2, center of 14) for allowing said depth guide to be movably connected to said side guide (13), and a depth guide knob (FIG 2, center of 14) bolted in said bolt hole of said depth guide. Shapiro et al disclose a bracket set, comprising a right bracket (5) pivotally coupled to the right side of said worktable board (17); a left bracket (4) pivotally coupled to the left side of said worktable board (17); and two carriage sliding shafts (2, 3), wherein both shaft ends of said carriage sliding shafts are coupled to the corresponding apertures on said right bracket (5) and said left bracket (4). Also disclosed is a blade carriage set, comprising a carriage (1) movably coupled to said carriage sliding shafts and sliding along said fixed blade at the top edge of said worktable board (17) back and forth; a blade (8) provided on said carriage (1) and sliding along the top edge of said worktable board (17) as said carriage (1) slides along said carriage sliding shafts (2, 3).

Shapiro et al fail to disclose a rotary blade, a fixed blade, rubber feet, or a paper holder.

Kozyrski discloses a safety cutter with a rotary blade (50) and a fixed blade (18) connected to the top edge of the worktable board (10). The fixed blade acts as a guide for the rotary blade and creates a clean cut. Therefore, it would have been obvious to

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one of ordinary skill in the art at the time the invention was made to provide a rotary blade and a fixed blade, as disclosed by Kozyrski, on the Shapiro et al device for the purpose of providing a clean cut.

Jones, III et al disclose a safety cutter with four rubber feet (62) disposed under the corners of the worktable board (22). The feet increase the stability of the device (col. 8, lines 11-14). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide four rubber feet, as disclosed by Jones, III et al, on the Shapiro device in order to increase stability.

Johnson discloses a safety cutter with a paper holder (21) that is flat and provided with a strip-shaped safety rim (49), and is provided with a blade accommodating slot (29), wherein both sides of the paper holder (21) are coupled to the bracket set (39, 41). Both sides of the paper holder (21) are coupled to the right bracket and the left bracket of the bracket set. The paper holder (21) clamps the paper (91) in place while the cut is being made for forming an accurate straight edge cut (col. 1, lines 44-46). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a paper holder, as disclosed by Johnson, on the Shapiro device in order to form an accurate cut.

Although Johnson does not disclose the safety rim of said paper holder is parallel with and protruded from the top edge of the worktable board, the paper holder is parallel with and protruded from a horizontal surface. To provide the top edge of the Shapiro worktable board with a safety rim protruding from the edge would have been obvious as taught by Johnson.

Regarding claim 2, Johnson discloses the safety rim (49) is integrally formed with the paper holder (21) onto the bracket set (39, 41). Note the method by which the apparatus is made does not further limit the claim. Thus, the reference shows the components are integrally formed. See MPEP § 2113.

Regarding claim 4, Johnson discloses the safety rim (49) is a bar.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rodriguez (5,819,618) and Logan (3,996,827 and 5,603,253) disclose safety cutters with side guides and blade carriages. Mori (5,069,097), Uehara et al (5,303,626), and McLean et al (2004/0149108 A1) disclose safety cutters with side guides, blade carriages, and paper holders.


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn T Blake whose telephone number is (703) 305-0390. The examiner can normally be reached on Monday to Friday, 8:00 AM to 5:30 PM, alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N Shoap can be reached on (703) 308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CB
November 2, 2004



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